UNITED STATES PATENT AND TRADEMARK OFFICE

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/034,427	12/27/2001	Joseph C. Kawan	CITI0241	1686

27510	7590	12/17/2004

KILPATRICK STOCKTON LLP
607 14TH STREET, N.W.
WASHINGTON, DC 20005

EXAMINER
CHEUNG, MARY DA ZHI WANG

ART UNIT	PAPER NUMBER
3621	

DATE MAILED: 12/17/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

PTO-90C (Rev. 10/03)

	Application No.	Applicant(s)
Office Action Summary	10/034,427	KAWAN ET AL.
	Examiner	Art Unit
	Mary Cheung	3621

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE <u>3</u> MONTH(S) FROM
THE MAILING DATE OF THIS COMMUNICATION.
- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed
  after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
  Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any
  earned patent term adjustment. See 37 CFR 1.704(b).

Status

1) ☒ Responsive to communication(s) filed on <u>30 September 2004</u>.
2a) ☐ This action is **FINAL**.   2b) ☒ This action is non-final.
3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is
   closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4) ☒ Claim(s) <u>1-24</u> is/are pending in the application.
   4a) Of the above claim(s) <u>13-19 and 21-24</u> is/are withdrawn from consideration.
5) ☐ Claim(s) _____ is/are allowed.
6) ☒ Claim(s) <u>1-12 and 20</u> is/are rejected.
7) ☐ Claim(s) _____ is/are objected to.
8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9) ☐ The specification is objected to by the Examiner.
10) ☒ The drawing(s) filed on <u>27 December 2001</u> is/are: a)☐ accepted or b)☒ objected to by the Examiner.
   Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
   Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
   a)☐ All   b)☐ Some * c)☐ None of:
   1. ☐ Certified copies of the priority documents have been received.
   2. ☐ Certified copies of the priority documents have been received in Application No. _____.
   3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage
      application from the International Bureau (PCT Rule 17.2(a)).
   * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
   Paper No(s)/Mail Date <u>4/10/02</u>.
4) ☐ Interview Summary (PTO-413)
   Paper No(s)/Mail Date. _____ .
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

DETAILED ACTION

Status of the Claims

1. This action is in response to the election of the restricted claims filed on September 30, 2004. Claims 1-24 are pending. Claims 1-12 and 20 are elected without traverse; thus, claims 13-19 and 21-24 are not elected and will not be examined. Claims 1-20 and 20 are examined.

Drawings

2. The drawings are objected to because in Figure 4, the item "Brower Plugin 30" should be labeled as "Brower Plugin 80". Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. The figure or figure number of an amended drawing should not be labeled as "amended." If a drawing figure is to be canceled, the appropriate figure must be removed from the replacement sheet, and where necessary, the remaining figures must be renumbered and appropriate changes made to the brief description of the several views of the drawings for consistency. Additional replacement sheets may be necessary to show the renumbering of the remaining figures. The replacement sheet(s) should be labeled "Replacement Sheet" in the page header (as per 37 CFR 1.84(c)) so as not to obstruct any portion of the drawing figures. If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

Claim Rejections - 35 USC § 102

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form

the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –
>
> (e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

4. Claims 1-2, 4-5, 8-11 and 20 are rejected under 35 U.S.C. 102(e) as being

anticipated by Foster, U. S. Patent 6,332,134.

As to claim 1, Foster teaches a method for facilitating a secure financial

transaction for a user over an open network, comprising (abstract):

a) storing a payment preference profile for the user consisting at least in part of

a designation of at least one user account for settlement of network transactions

for the user on a customer payment options profile and authentication information

database of a financial institution (column 4 lines 57-59 and column 5 lines 5-44

and Fig. 2; *specifically, "payment preference profile" corresponds to the*

information such as account number in Foster's teaching, and "authentication

information database" corresponds to the card company's records that comprise

user's ID and password);

b) receiving a user-initiated request by the financial institution for settlement of a

network transaction with a merchant (column 7 line 37 – column 8 line 20 and

Figs. 2-3);

c) accessing a customer authentication and authorization server by the financial institution in regard to the user (column 5 lines 32-34 and column 8 lines 19-50 and column 16 lines 37-52);

d) securely accessing the user's payment preference profile on the customer payment options profile and authentication information database by the customer authentication and authorization server to identify the user account designated for settlement of network transactions for the user (column 5 lines 32-34 and column 8 lines 19-50 and column 16 lines 37-52);

e) initiating settlement of the network transaction with the designated account by a deal closing server of the financial institution, if the user-initiated request for settlement is authenticated and authorized by the customer authentication and authorization server (column 8 lines 42-53 and Fig. 2);

f) notifying the merchant of payment and confirming completion of settlement of the network transaction to the user by the deal closing server (column 8 lines 42-53 and Fig. 2).

As to claim 2, Foster teaches storing the payment preference profile for the user further comprises storing other preferences and rules for the user instructing the user's financial institution in handling network-negotiated transactions for the user (column 12 lines 1-17 and column 14 lines 9-21).

As to claim 4, Foster teaches storing other preferences and rules for the user further comprises storing rules for each user account designated for settlement of network transactions for the user (column 14 lines 9-21).

As to claim 5, Foster teaches storing the payment preference profile for the user further comprises allowing the user to update the payment preference profile through at least one of the Internet through a designated financial institution website server, telephonically through a customer service representative, and through mail (column 6 line 34 – column 7 line 14 and column 10 lines 1-12).

As to claim 8, Foster teaches receiving the user-initiated request by the financial institution further comprises allowing the user to select an alternative payment option 9column 7 lines 11-14 and column 10 lines 1-12).

As to claim 9, Foster teaches receiving the user-initiated request by the financial institution further comprises allowing a browser plug-in of a processor of the user to access the processor and formulate a secure electronic authorization/payment message and send the message back through the browser plug-in to an electronic address for a merchant server (column 1 lines 31-49 and column 6 lines 35-42 and column 7 line 37 – column 8 line 47 and column 12 line 34 – column 13 line 9 and Figs. 1-3, 8-9).

As to claim 10, Foster sending the message back through the browser plug-in to the merchant server further comprises passing the message securely through the merchant server to the deal closing server of the financial institution (column 1 lines 31-49 and column 6 lines 35-42 and column 7 line 37 – column 8 line 47 and column 12 line 34 – column 13 line 9 and Figs. 1-3, 8-9).

As to claim 11, Foster teaches accessing the customer authentication and authorization server by the financial institution according to identifying information for

the user securely stored on a processor located at a remote site of the user, wherein the

processor comprises a personal computer (column 5 lines 17-34).

As to claim 20, Foster teaches a system for facilitating a secure financial

transaction for a user over an open network, comprising (abstract):

a) a customer payment options profile and authentication information database

of a financial institution storing a payment preference profile for a user consisting

at least in part of a designation of at least one user account for settlement of

network transactions for the user (column 4 lines 57-59 and column 5 lines 5-44

and column 15 lines 4-8 and Fig. 2; *specifically, "payment preference profile"*

corresponds to the information such as account number in Foster's teaching, and

"authentication information database" corresponds to the card company's records

that comprise user's ID and password);

b) a deal closing server of the financial institution for receiving a user-initiated

request by the financial institution for settlement of a network transaction with a

merchant (column 7 line 37 – column 8 line 20 and Figs. 2-3);

c) a customer authentication and authorization server of the financial institution

accessible by the deal closing server for securely accessing the user's payment

preference profile on the customer payment options profile and authentication

information database to identify the user account designated for settlement of

network transactions for the user, wherein the deal closing server is adapted to

initiate settlement of the network transaction with the designated account, if the

user-initiated request for settlement is authenticated and authorized by the

customer authentication and authorization server, and wherein the deal closing

server is further adapted to notify the merchant of payment and confirm

completion of settlement of the network transaction to the user (column 5 lines

32-34 and column 8 lines 19-53 and column 16 lines 37-52 and Fig. 2).

Claim Rejections - 35 USC § 103

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all

obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

6. Claims 3 is rejected under 35 U.S.C. 103(a) as being unpatentable over Foster, U.

S. Patent 6,332,134 in view of Steinberg, U. S. Patent 6,618,763.

As to claim 3, Foster teaches storing other preferences and rules for the user

instructing the user's financial institution in handling transactions as discussed above.

Foster does not specifically teach wherein storing other preferences and rules for the

user further comprises storing a hierarchical order in which user accounts designated

for settlement of network transactions for the user should be accessed for payment.

However, this matter is taught by Steinberg as delivering information in a hierarchical

order defined by the user (column 2 line 62 – column 3 line 19 and Figs. 3A-3B). It

would have been obvious to one of ordinary skill in the art at the time the invention was

made to allow other preferences and rules in Foster's teaching to be defined in a

hierarchical order by the user as taught by Steinberg so that the transactions can be

efficiently processed.

7. Claims 6-7 and 12 are rejected under 35 U.S.C. 103(a) as being unpatentable over

Foster, U. S. Patent 6,332,134 in view of Davis et al., U. S. Patent 6,282,522.

As to claims 6-7, Foster teaches receiving the user-initiated request by the

financial institution further comprises receiving payment settlement information over the

open network and the information is securely stored on a processor located at a remote

site of the user, wherein the processor comprises a personal computer as discussed

above. Foster further teaches using various encryption schemes to provide a secure

environment for transactions (column 1 lines 19-29). Foster does not specifically teach

receiving the user-initiated request by the financial institution further comprises

receiving payment settlement information over the open network from the user

protected by a private key issued by the financial institution for electronic messages

which the user intends to be viewed by the financial institution. However, this matter is

taught by Davis as the information transmitted from the user is protected by an

encryption key issued by the payment server and stored in a processor located at a

remote site of the user, wherein the processor comprises one of a personal computer

and a smart card (column 11 lines 15-67; Fig. 5 and its associated text). It would have

been obvious to one of ordinary skill in the art to allow the various encryption schemes

in Foster's teaching to include the feature of the payment settlement information

received from the user that is protected by a security key issued by the financial

institution and stored in remote site of the user for preventing the information from

tampering.

As to claim 12, Foster teaches accessing the customer authentication and authorization server according to the identifying information for the user securely stored on the user's computer processor that was programmed by the financial institution when the payment preference profile was stored for the user (column 5 lines 17-34 and column 6 lines 25-46). Foster does not specifically teach the user's computer processor is a smart card processor. However, Davis teaches this matter (column 11 lines 27-38 and column 12 lines 1-22). It would have been obvious to one of ordinary skill in the art at the time the invention was made to allow the user's computer processor in Foster's teaching to be a smart card processor for expanding the usage environment of Foster, and thus attracting more people to use Foster's teaching.

Conclusion

8. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Stein et al. (U. S. Patent 5,826,241) discloses computerized system for making payments and authenticating transactions over the Internet.

Gifford (U. S. Patent 6,205,437) discloses open system payment system for providing for real-time authorization of payment and purchase transactions.

Cook et al. (U. S. Patent 6,675,153) discloses transaction authorization system.

Johnson et al. (WO 99/03075) discloses automated loan repayment.

Inquire

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Mary Cheung whose telephone number is (703)-305-0084. The examiner can normally be reached on Monday – Thursday from 10:00 AM to 7:30 PM. The examiner can also be reached on alternate Fridays.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, James Trammell, can be reached on (703) 305-9768.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-1113.

The fax phone number for the organization where this application or proceedings is assigned are as follows:

(703) 872-9306   (Official Communications; including After Final

Communications labeled "BOX AF")

(703) 746-5619   (Draft Communications)

Hand delivered responses should be brought to Crystal Plaza Two, Room 1B03.

Mary Cheung
Patent Examiner
Art Unit 3621
December 13, 2004